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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/834,506	04/12/2001	Sung Soo Chung	CISCO-3024	5788
49715	7590	06/03/2005	EXAMINER	
THELEN REID & PRIEST LLP			CHAUDRY, MUJTABA M	
CISCO			ART UNIT	
P.O. BOX 640640			PAPER NUMBER	
SAN JOSE, CA 95164-0640			2133	

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/834,506

Applicant(s)

CHUNG ET AL.

Examiner

Mujtaba K. Chaudry

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8, 13, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8, 13, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 1, 5, 13, 25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8, 13, 25 and 26 of present Application, 09834506, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of Srinivasaiah et al. USPN 681377, both which are assigned to Cisco Technology Inc. Although the conflicting claims are not identical, they are not patentably distinct from each.

Reference 6813737 (herein after: Reference '737) teaches (title and abstract) an apparatus and a method for testing Alternating Current (AC) coupled interconnects of a circuit using boundary scan methodology are disclosed. A boundary scan cell (BSC) of a transmitting Integrated Circuit (IC) generates an AC signal based on a value of the BSC of the transmitting IC and a reference clock. A Sync Pulse cell at the receiving IC generates a sync pulse signal to the BSC of the receiving IC. The BSC of the receiving IC captures a default phase of the AC signal in relation to the sync pulse signal and also captures a phase of a source of input signal. The BSC of the receiving IC then compares the phase of a source of input signal with the phase of said AC signal in relation to the phase captured at the sync pulse signal and sends out an output signal based on the comparison. Reference '737 teaches (col. 7) a method for testing a circuit including AC coupled interconnects the circuit having a transmitting IC and a receiving IC that are coupled together by an AC interconnection, each IC having a Boundary Scan Cell (BSC) connected to a reference clock, the method comprising: generating an AC signal based on the reference clock and a value held in the BSC of the transmitting IC, the AC signal having a first phase if a first value is held in the BSC, and a second phase if a second value is held in the BSC; generating, for the receiving IC, a sync pulse signal based on a test reset signal; capturing, in the SC of the receiving IC, a default phase of said AC signal in response to said sync pulse signal; sampling a phase of the AC signal; comparing the default phase with the sampled phase of the AC signal; and generating a phase decode signal based on said comparing. The examiner would like to point out that the process of testing is essentially the same in the present application and the Reference '737. The Reference '737 does not explicitly teach to move the TAP controller to Run-test/idle state during testing. However, this step is inherent in order for the testing to take

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place. Again the examiner would like emphasize that although the two inventions are not 'exactly' the same, they are **not patentably distinct** because the process remains essentially the same and hence one is just an embodiment of the other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Objections

Claim 1 is objected to because of the following informalities:


- In paragraph 3 of claim 1, the term "initiate" should perhaps be "initial".


Appropriate similar correction is also required in subsequent claims 5, 13, 25 and 26.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Any inquiries concerning this communication should be directed to the examiner, Mujtaba Chaudry who may be reached at 571-272-3817.

The examiner may normally be reached Mon – Thur 6:30 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, please contact the examiner's supervisor, Albert DeCady at 571-272-3819.


Mujtaba Chaudry
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May 18, 2005


ALBERT DECADY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100